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Re: U.S. Patent Application No. 10/634,990 filed 08/06/2003
Title: Automatic Labelling and Packaging System Label Folding and Application
First Inventor: Dennis W. Rice
Examiner: Linda Lamey Gray Group Art Unit: 1734
Attorney Docket No.: 103864.134-US1

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Response to Restriction Requirement

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|--|---|----------------------------|
| In re Application of | : | |
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| Dennis W. RICE et al. | : | Confirmation No. 7455 |
| | : | |
| Serial No. 10/634,990 | : | Group Art Unit: 1734 |
| | : | |
| Filed: August 6, 2003 | : | Examiner: Linda Lamey Gray |
| | : | |
| For: AUTOMATIC LABELING AND PACKAGING SYSTEM LABEL FOLDING AND APPLICATION | | |

RESPONSE TO RESTRICTION REQUIREMENT

Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

This is in response to the Office Action issued January 11, 2005, having a one-month shortened statutory period of response set to expire by February 11, 2005.

ELECTION

Applicant hereby elects, with traverse, Group III (claims 34-35, 56-58 and 59-61, drawn to the apparatus for producing a label, classified in class 156, subclass 443) for prosecution.

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REMARKS

In the Office Action, the Examiner noted that claims 1-67 are pending in the application, and that claims 1-67 are subject to restriction and/or election.

By this Amendment, Applicant has elected Group II for prosecution, including claims 34-35, 56-58 and 59-61, drawn to the apparatus for producing a label. Accordingly, claims 1-67 remain pending in the application, and claims 1-33 and 62-67 are withdrawn from consideration at this time.

Applicant respectfully traverses this restriction requirement. Specifically, both sets of groups emphasize similar limitations relating to a label apparatus and/or method, and including reducing of the label in connection therewith.

Further, the Examiner is likely to require searching in both Subclasses 227 and 443 in class 156 and subclass 40.1 in class 428 in any event for all of the inventions, and therefore, Applicant does not understand the excessive burden on the Examiner to examine both groups of claims. Withdrawal of this Restriction Requirement is respectfully requested.

For example, in *Ex parte Dryssen*, 4 USPQ 338, 339 (Bd. Pat. App. 1930), the Patent Office Board considered restriction improper under the similar circumstances in the present application. As stated by the Board therein:

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There is no question but that it is the common practice in this office to allow method claims in the same application as apparatus claims and where the claims relate to the same subject matter of invention we consider that this practice is permissible. Method claims usually differ somewhat in scope from apparatus claims or at least they set forth the invention in different terms.

Similarly, in *Ex parte Pratt*, 46 USPQ 560, 561 (Bd. Pat. App. 1940), the Patent Office Board held the following:

There is also reference to the classification of Venetian blinds now proceeding. What the Classification Division may do in the general revision of a class cannot have a conclusive bearing on a question of division in a particular case. We do not understand that classification of patents is for the purpose of establishing lines of division between claims. It is rather for the purpose of quickly locating pertinent art. For this purpose, cross-references may be properly placed.

Accordingly, Applicant respectfully traverses the restriction requirement.

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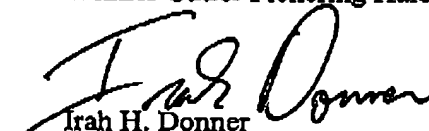
AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment to Deposit Account No. 08-0219.

In the event that an Extension of Time is required, or which may be required in addition to that requested in a petition for an Extension of Time, the Commissioner is requested to grant a petition for that Extension of Time which is required to make this response timely and is hereby authorized to charge any fee for such an Extension of Time or credit any overpayment for an Extension of Time to Deposit Account No. 08-0219.

Respectfully submitted,

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